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10/534,482	05/10/2005	Alexis S. R. Ashley	GB 020194	7020
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EXAMINER				
BILAS, ROBERT				
ART UNIT		PAPER NUMBER		
4121				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/534,482

**Applicant(s)**

ASHLEY, ALEXIS S. R.

**Examiner**

ROBERT BILAS

**Art Unit**

4121

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 May 2005.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 - 13 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1 - 13 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 10 May 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date 02/21/2006  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Abstract**

1. In the next to last sentence, the word "store" is incorrect. The word "store" should be removed in order to clarify the abstract.

Appropriate correction is required.

### **Drawings**

2. In the Drawings section, for figure 3, the data bus needs "52" added. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the

applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### **Specifications**

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

In the specifications, on page 4 of the second paragraph, "(to the right)" should be --(to the left)--. On page 5, line 34, "that raw" should be --other than raw--. On page 5, line 34, "suitable" should be --suitably--. On page 8, line 18, "store the" should be --the stored--.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claim 12 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim language "software utility" is not a process, machine, method, composition of matter or a new and useful improvement thereof. The language of this claim is composed of non-statutory subject matter and the claim is not patentable.

***Claim Construction***

6. In claim 7, the “storage means for” is not being construed under 112 6<sup>th</sup> paragraph because it is not followed by functional language; “communications means”, “processor means”, “storage means” and “communications means” are not being construed under 112 6<sup>th</sup> paragraph because they lack the word “for”.

In claim 8, “processor means” and “input means” are not being construed under 112 6<sup>th</sup> paragraph because they lack the word “for”.

In claim 9, “processor means” is not being construed under 112 6<sup>th</sup> paragraph because the word “for” is not used.

In claim 10, “storage means” and “processor means” are not being construed under 112 6<sup>th</sup> paragraph because they lack the word “for”.

In claim 11, “processor means” is not being construed under 112 6<sup>th</sup> paragraph because the word “for” is not used.

***Claim Rejections – 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1 – 13 are rejected under U.S.C. 102(e) as being anticipated by Desai et al U. S. 6820204, hereinafter referred to as Desai.

For claim 1, Desai teaches

providing (18) from said second computer to said first computer a privacy policy identifying the personal data required to be provided to permit access to said user group (see column 17, lines 14 – 18). The requested data element has a universal ID. The identification of the data element occurs using the universal ID. Individual users will have different ID's. Thus, the ID is a privacy policy;

at said first computer determining (22) whether a received privacy policy is acceptable (see last two sentences of the abstract and column 17, lines 16 - 20); and

if acceptable, at the first computer selecting (30) from store the personal data identified in the privacy policy and transmitting (28) the same to the second computer (see last two sentences of the abstract).

For claim 2, Desai teaches

the first computer presents a received privacy policy to a user, and acceptance or otherwise of said policy is determined by user input (24) (see column 4, lines 2 - 7).

For claim 3, Desai teaches

the first computer formats the received privacy policy prior to presentation to the user (see column 9, lines 19 -22).

For claim 4, Desai teaches

the first computer stores privacy policy preference data for a user (see column 3, lines 42 - 45) and, based (26) on the same, determines (30) automatically whether a received privacy policy is acceptable (see column 4, lines 15 - 18).

For claim 5, Desai teaches

the step (22) of determining acceptance includes a process of negotiation (38) between the first computer user and the user group host (see the next to last sentence of the Abstract).

For claim 6, Desai teaches

a received privacy policy may be partly accepted (22.B), with only a part (30.B) of the requested personal data being transmitted (28) as a result, and only limited access being granted to the on-line user group (see column 4, lines 55 - 61).

For claim 7, Desai teaches

storage means (54, 56, 68) for personal data of a user of the apparatus (see column 18, lines 19 -21);

communications means (58) operable to exchange data with the second computer over a data link (60) and receive from said second computer a privacy policy identifying the personal data required to be provided to permit access to said user group (see column 18, lines 22 – 24 and fig. 16 where the network is numbered as 503 );

programmable processor means (50) (see block 502 of fig. 16) configured to determine whether a received privacy policy is acceptable (see claim 16: the first network server including: a first processor; and a first program memory connected to the first processor and having program instructions stored therein, the first processor being

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operable to execute the program instructions, the program instructions including: for each registered user, selectively granting and denying access to each of the registered user's associated data elements, to other users in the network.) and, if so, to select from said storage means (54, 56, 68) the personal data identified in the privacy policy and, via the communications means (58), transmit (see column 27, lines 30 - 31) the same to the second computer.

For claim 8, Desai teaches

an output device (64) (see the monitor of block 12 of fig. 1) wherein the processor means (50) (inside the console of block 12 of fig. 1) presents a received privacy policy to a user (see column 9, lines 10 - 14), and user input means (62) (see the keyboard of block 12 of fig. 1) by operation of which a user determines acceptance or otherwise of said policy (see column 4, lines 29 - 31).

For claim 9, Desai teaches

the processor means (50) is arranged to format the received privacy policy (see column 9, lines 49 - 52) prior to presentation by the output device (64).

For claim 10, Desai teaches

the processor means (50) determines automatically whether a received privacy policy is acceptable (see column 4, lines 15 - 18).

For claim 11, Desai teaches

the processor means (50) is further operable to determine partial acceptance of a received privacy policy, and to select from said storage means (54, 56, 68) only a part of the requested usage data (see column 4, lines 18 - 20).

For claim 12, Desai teaches

A software utility operable to configure a programmable device to perform the functions of the first computer in a method as claimed in claim 1 (see column 4, lines 55 - 61).

For claim 13, Desai teaches

A storage device (68) holding a software utility as claimed in claim 12 (See block 502 of fig. 16. A CPU inherently has a memory containing instructions that run the CPU. Even though no memory is shown in fig. 16, it is inherently present).

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Koseki, U. S. 2002/0049758; [www.tml.tkk.fi/Opinnot/Tik-110.501/1999/papers/anonymity/anonpriv.html](http://www.tml.tkk.fi/Opinnot/Tik-110.501/1999/papers/anonymity/anonpriv.html); [www.w3.org/TR/P3P](http://www.w3.org/TR/P3P)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT BILAS whose telephone number is (571)270-5658. The examiner can normally be reached on Monday - Thursday, Alt. Friday, 7:30am -5pm EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Robertson can be reached on 571-272-4186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. B./  
ROBERT BILAS  
Examiner, Art Unit 4121  
7/29/08

/David L Robertson/  
Supervisory Patent Examiner  
Art Unit 4121